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In re Application of: David S. Stork)	DECISION ON PETITION UNDER 37
Application No. 09/534,950)	CFR § 1.181 TO INVOKE
Filed: March 24, 2000)	SUPERVISORY AUTHORITY AND
For: A METHOD AND APPARATUS FOR)	FOR REFUND OF FEE PURSUANT
OPEN DATA COLLECTION)	TO 37 C.F.R. 1.26(a)

This is a decision on the petition under 37 CFR 1.181, filed July 7, 2003 requesting the Group Director to enter an amendment which was refused entry in the Advisory action mailed on May 14, 2003. Petitioner further requests refund of the fees for the concurrently filed RCE and extension of time pursuant to 37 C.F.R. 1.26(a).

The petition is **DISMISSED**.

CASE HISTORY

A final Office action rejecting claims 1, 2, 6, 7, 10, 12, and 17-20, allowing claims 15 and 16, and objecting to claims 3-5, 8, 9, 11, 13, 14, 21, and 21 as depending from rejected base claims was mailed on January 29, 2003. Applicant filed a proposed amendment after final on May 5, 2003. The Examiner responded with an Advisory action mailed May 14, 2003 indicating that the proposed amendment after-final would not be entered because it raises New Issues that would require further search and/or consideration.

On July 7, 2003, Petitioner (1) filed the instant petition contending that the proposed amendment should have been entered and requesting that the Examiner be directed to enter the amendment and pass the case to issue and (2) Filed a Request for Continuing Examination and 2-month extension of time. The RCE transmittal did not request entry of the May 5 amendment after final but instructed the Office to enter an amendment submitted as part of the July 7 filing. These papers carried a certificate of mailing establishing the date of filing as May 30, 2003.

BASIS OF OPINION

The relevant portions of the Statutes and Rules are reproduced below. Emphasis is added to draw attention to the critical phrases.

§ 1.26 Refunds.

(a) ***The Commissioner may refund any fee paid by mistake or in excess of that required.***

A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent or trademark filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts. If a party paying a fee or requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer (31 U.S.C. 3332 and 31 CFR part 208), or instruct the Office that refunds are to be credited to a deposit account, the Commissioner may require such information, or use the banking information on the payment instrument to make a refund. Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged.

37 CFR § 1.135 Abandonment for failure to respond within time period.

(a) If an applicant of a patent application fails to respond within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper action as the condition of the case may require. ***The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.***

37 CFR § 1.116 Amendments after final action or appeal.

(a) After a final rejection or other final action (§ 1.113)...amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. ***The admission of, or refusal to admit, any amendment after final rejection, and any related proceedings, will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135.***

The relevant section of the MPEP concerning entry of amendments after a final rejection is MPEP § 714.13 which states:

ENTRY NOT A MATTER OF RIGHT

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims. Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way ***requires only a cursory review by the examiner***, compliance with the requirement of a showing under 37 CFR 1.116(b) is expected in all amendments after final rejection.

OPINION

I. Entry of the Amendment Filed May 5, 2003.

The newly proposed claim 11 is *not equivalent to any previously presented claim*, but rather is of a scope not previously presented. Specifically, newly proposed claim 11 is broader in scope than the previous version of claim 11 which had been indicated as allowable if presented in independent form¹. Accordingly, the amendment clearly fails to simplify the issues, in fact, it raises new issues and would have required further search and/or consideration if entered. As such, the examiner acted properly and within his duties to deny entry of this amendment.

The examiner's refusal to enter the proposed amendment is correct and consistent with Office policy and practice. Accordingly, the Petition to compel the examiner to enter the amendment filed May 5, 2003 is **DISMISSED**.

II. Refund of Fees

As set forth in 37 C.F.R. §1.116, an "*admission of...any amendment after final rejection...will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under §1.135*" (emphasis original). It is Applicant's responsibility after a final action to ensure that the application is not abandoned, regardless of the status of any after-final amendment filed with the Office or any advisory action mailed by the Office.

Applicant elected² to avoid the possibility of abandonment by filing an RCE accompanied with the appropriate fees on July 7, 2003.

The extension of time fee paid on July 7, 2003 was necessary to prevent the application from going abandoned. Therefore, the fee paid was not a mistake (a fee paid when no fee is required) in accordance with 37 C.F.R. 1.26(a). The fee of \$410.00 paid by Applicant was also the proper extension of time fee for a two month extension of time at the time the fee was paid. Therefore, the fee paid was not in excess of the amount of fee that was required. See also MPEP §607.02. Since

¹ Note further that although amended claim 20 appears to be narrower than previously presented claim 22, the underlining and cross-out are not consistent with the changes from the previous claim 20.

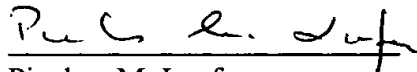
² Applicant could have filed the Petition upon receipt of the advisory without paying any fees, and could have filed a Notice of appeal at the 6-month date to prevent the case going abandoned if no decision had been rendered.

the fee paid was not a mistake or in excess of the required amount, the request for a refund does not fit under the categories of reasons for the Office to grant a refund as set forth in 37 C.F.R. 1.26(a) and the fee should not be refunded in accordance with the provisions of 37 C.F.R. 1.26(a).

Similarly the fee of \$750.00 paid by Applicant was the proper fee for the filing of an RCE. Applicant elected to file an RCE, accordingly the fee paid was not a mistake or in excess of the required amount, the request for a refund does not fit under the categories of reasons for the Office to grant a refund as set forth in 37 C.F.R. 1.26(a) and the fee should not be refunded in accordance with the provisions of 37 C.F.R. 1.26(a).

The petition to refund the two month extension of time fee of \$410 and the RCE filing fee of \$750 in accordance with 37 C.F.R. 1.26(a) is **DISMISSED**.

Inquiries with respect to this decision may be directed to Special Programs Examiner Pinchus M. Laufer at (703) 306-4160.



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